

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

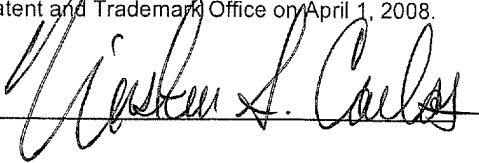
# PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

9564-27

I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) to the U.S. Patent and Trademark Office on April 1, 2008.

Signature



Typed or printed name

Kirsten S. Carlos

Application Number

10/534,139

Filed

05/06/2005

First Named Inventor

Henrik Borjesson

Art Unit

2617

Examiner

Marcos L Torres

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 42,011

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34



Signature

D. Scott Moore

Typed or printed name

919/854-1400

Telephone number

April 23, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒

\*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**RESPONSE UNDER 37 C.F.R. 1.116  
EXPEDITED PROCEDURE  
EXAMINING GROUP 2617**

ATTORNEY DOCKET NO. 9564-27

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Henrik Borjesson

Serial No.: 10/534,139

Filed: May 6, 2005

For: *Device And Method For Generating An Alert Signal*

Confirmation No.: 8489

Group Art Unit: 2617

Examiner: Marcos L Torres

April 24, 2008

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**REASONS IN SUPPORT OF APPLICANTS' PRE-APPEAL  
BRIEF REQUEST FOR REVIEW**

Sir:

This document is submitted in support of the Pre-Appeal Brief Request for Review filed concurrently with a Notice of Appeal in compliance with 37 C.F.R. 41.31 and with the rules set out in the OG of July 12, 2005 for the New Appeal Brief Conference Pilot Program, which have been extended indefinitely.

No fee or extension of time is believed due for this request. However, if any fee or extension of time for this request is required, Applicants request that this be considered a petition therefor. The Commissioner is hereby authorized to charge any additional fee, which may be required, or credit any refund, to our Deposit Account No. 50-0220.

Applicants hereby request a Pre-Appeal Brief Review (hereinafter "Request") of the claims finally rejected in the Final Office Action mailed January 25, 2008 (hereinafter "Final Action"). The Request is provided herewith in accordance with the rules set out in the OG dated July 12, 2005.

Applicants respectfully submit that the rejections of the currently pending claims under Section 102 are clearly erroneous for at least the reason that the cited reference fails to disclose or

suggest making a geographic alert conditional on a time condition as recited in independent Claims 1 and 14 and as discussed herein and in Applicants' previously filed Amendment dated October 30, 2007. Therefore, Applicants respectfully request review of the present application by an appeal conference prior to the filing of an appeal brief. In the interest of brevity and without waiving the right to argue additional grounds should this Petition be denied, Applicants will only discuss the recitations of independent Claims 1 and 14.

**Independent Claims 1 and 14 are Patentable**

Independent Claims 1 and 14 stand rejected under 35 U.S.C. §102(b) as being anticipated by U. S. Patent No. 5,938,721 to Dussell et al. (hereinafter "Dussell"). (Final Action, page 3). Independent Claim 1 is directed to a device for generating an alert signal and recites, in part:

...  
calendar means for storing calendar entries;  
clock means for keeping track of the actual time; and  
second trigger means for comparing the actual time with a calendar entry  
and triggering generation of said alert signal when the actual time matches the  
calendar entry, but only when the distance between the actual position of the  
device and the location of the place of interest is less than the predetermined value  
(r);  
...

Independent Claim 14 includes similar recitations. According to the independent claims, the actual time may be tracked and an alert signal generated only when the distance between the device's position and the place of interest is less than a predetermined value **and** there is a match between the actual time and a calendar entry. This is described, for example, in the Specification at page 6, lines 8 – 17.

The Final Action cites the passages from Dussell at col. 7, lines 15 – 32 and col. 9, lines 10 – 15 in rejecting dependent Claim 9. (Final Action, page 3). The passage at col. 7, lines 15 – 32, however, explains that conventional scheduling programs provide an ability to store reminders in the form of "to-do" lists. The passage goes on to explain that the focus of Dussell's disclosure is to provide "a means by which tasks can be scheduled and/or prioritized based on

location." (Dussell, col. 7, lines 23 – 24). The second passage cited in rejecting dependent Claim 9 at col. 9, lines 10 – 15 explains that the database 10, which includes the geocoded references, can be accessed by various types application programs, such as calendaring and scheduling programs that run on the computer system 20. After reviewing these passages, Applicants submit that Dussell merely discloses the capability of generating an alert once a mobile device comes within a predetermined range of a defined geographic location. Dussell does not disclose or suggest modifying this capability to make the alert conditional on satisfying a time condition, such as a date on a calendar, for example. Applicants acknowledge that Dussell mentions that the geocoded references can be accessed by calendaring and scheduling programs at col. 9, lines 10 – 15. But when this excerpt is placed in context by reviewing the entire paragraph of which it is a part, the excerpt appears to be referring to the ability to program the geocoded references into the database 10 (Dussell, col. 9, lines 3 – 15). Applicants submit, therefore, that Dussell fails to disclose or suggest, at least, making a geographic alert conditional on a time condition as recited in independent Claims 1 and 14.

In response to this argument, the Final Action on page 2 points out that Dussell describes their disclosure as a "a means by which tasks can be scheduled and/or prioritized based on location." (Dussell, col. 7, lines 23 – 24). The Final Action further cites col. 7, lines 13 - 31 of Dussell as teaching that prioritization can be based on due dates. (Final Action, page 2). Applicants respectfully submit that these portions of Dussell taken in isolation do not provide an accurate representation of their meaning. The relevant passages from Dussell read as follows:

Typically, mobile computer system 20 will store various application programs, including a scheduling program which allows an operator to store reminders in the form of "To-Do" lists or other forms. Such scheduling programs are common in the art and often allow the user to prioritize tasks to be accomplished according to a variety of criteria, including due dates, etc. (Dussell, col. 7, lines 16 - 22).

Thus, Dussell first explains that conventional scheduling programs allow a user to prioritize tasks based on due dates and store reminders associated with the tasks. Dussell then proceeds to describe how their disclosure is different from the conventional art:

The present invention provides a means by which tasks can be scheduled and/or prioritized based on location. (Dussell, col. 7, lines 22 - 24).

Dussell explains that conventional systems prioritize tasks based on due dates, but their disclosure is different from conventional systems and is directed to scheduling/prioritizing tasks based on location. To illustrate this distinction, Dussell provides an example that a task descriptor may be "PICK UP MILK" and the location reference may be "GROCERY STORE." When a user is near the grocery store, the "PICK UP MILK" task becomes a priority and the user is alerted. Dussell provides no mention that the geographic alert associated with being near the grocery store may also be conditional on some type of time condition. (Dussell, col. 7, lines 30 - 41). Accordingly, Applicants continue to maintain that Dussell fails to disclose or suggest, at least, making a geographic alert conditional on a time condition as recited in independent Claims 1 and 14.

For at least the foregoing reasons, Applicants respectfully request that the present application be reviewed and that the rejection of independent Claims 1 and 14 be reversed by the appeal conference prior to the filing of an appeal brief.

Respectfully submitted,



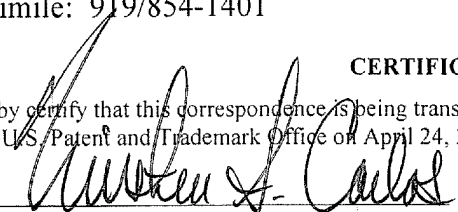
D. Scott Moore  
Registration No. 42,011

**USPTO Customer No. 20792**

Myers Bigel Sibley & Sajovec  
Post Office Box 37428  
Raleigh, North Carolina 27627  
Telephone: 919/854-1400  
Facsimile: 919/854-1401

**CERTIFICATION OF TRANSMISSION**

I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) to the U.S. Patent and Trademark Office on April 24, 2008.



Kirsten S. Carlos